

REMARKS

This is a response to the final Office Action mailed January 21, 2004, in relation to the above-identified patent application. Claims 1-20 are presently pending. Claims 11, 19, and 20 have been amended by this response.

In the Office Action, the Examiner objected to claims 11, 19, and 20 based upon matters of formality. The claims have been amended accordingly.

The Examiner also rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Massengill, in view of Broderick or Onyshkevych. In this rejection, the Examiner stated that "Massengill lacks the express written disclosure of performing the method without using an image of the patent." Thus, the Examiner is apparently relying upon either Broderick or Onyshkevych to cure the deficiencies of Massengill alone to make the claimed invention obvious.

The Examiner states that Broderick discloses "a method of providing a preview image of a cosmetic procedure for the eyes comprising asking multiple choice questions and using the answers over a network to form the image from a database of pre-existing images for the patent to select from and modify."

However, it is important to appreciate that a "cosmetic procedure" is not a cosmetic surgery procedure. Some of the important differences between a cosmetic procedure and a cosmetic surgery procedure include the techniques used (cutting or otherwise modifying tissue versus painting or otherwise changing the color or appearance of the skin); cost (surgery is much more expensive than the application of cosmetics); results (surgery tends to be permanent, whereas the application of cosmetics tends to be temporary); and reversibility (surgery tends to be difficult to reverse, whereas cosmetics can be easily removed).

Moreover, surgery and cosmetics tend to be practiced by different groups of people. Surgeons are highly trained, well educated, medical doctors. Cosmeticians are sales people.

The use of cosmetic contact lenses falls easily into the broad category of cosmetics and does not in any manner fall into the category of surgery. Thus, it is respectfully submitted that cosmetic surgery and the use of cosmetic contact lenses are in two widely divergent fields.

As such, it is respectfully submitted that the cosmetic contact lenses of Broderick constitute non-analogous art with respect to the cosmetic surgery as taught by Massengill and that the combination of Broderick with Massengill is thus improper. One looking to improve the cosmetic procedures of Massengill simply would not look to the teachings of cosmetics provided by the Broderick patent to find solutions to problems. There is thus no motivation to combine Massengill and Broderick.

The Examiner further states that Onyshkevych discloses “a method of providing internet based transactions, including cosmetic surgery, in which the user may answer qualitative and/or quantitative questions to produce a digitized image from a database or select a similar image from a database . . .”

However, it is important to appreciate that the Onyshkevych reference does not actually disclose any detail regarding the use of such a method in cosmetic surgery. Rather, the Onyshkevych reference teaches a method for determining the size of a garment and merely mentions that “alternate embodiments of the present invention include, but are not limited to, sporting equipment (equipment, protective gear, athletic wear); furniture (selection and design); home and personal products; cosmetics (matched or made for body/skin type) automotive, especially, ergonomics (car seats, baby seats); medical, prosthetics devices and diagnostic services; cosmetic surgery – visualization and solicitation; and health, diet, food – evaluation, recommendation, visualization and sales of product and services.”

Cosmetic surgery is one item buried in a long laundry list of possible applications of the methodology of Onyshkevych. Even one intent on finding such a mention of cosmetic surgery in this reference could easily miss it.

More importantly, the mere mentioning that something is possible is not the same as a disclosure that is suitable for a rejection under 35 U.S.C. 103. In order to qualify as a proper

disclosure for use in a rejection under 35 U.S.C. 103, the disclosure must be sufficiently enabling so as to make the claimed subject matter obvious.

It is respectfully submitted that the material of Onyshkevych is so different from that of the present invention (garment fitting and sizing versus cosmetic surgery) that one would not look to Onyshkevych to solve cosmetic surgery problems in the first place, but even if one did, it certainly is not obvious that the teachings of Onyshkevych with respect to garment fitting and sizing can be applied to cosmetic surgery.

Onyshkevych completely lacks any teaching as to how its fitting and sizing techniques can be applied to cosmetic surgery, and thus does not qualify as a proper reference under 35 U.S.C. 103. It is not even clear that the fitting and sizing techniques of the Onyshkevych reference can actually be applied to cosmetic surgery.

Indeed, even if the fitting and sizing techniques can, in some fashion, be applied to cosmetic surgery, it is important to appreciate that these techniques tend to be inherently gross in their very nature. That is, the information needed for the fitting and sizing of garments is inherently less detailed than the information needed for the cosmetic surgery procedures of the present invention.

Cosmetic surgery is thus one of many applications in a long list of possibilities, without any specific disclosure of how the techniques described with respect to garment fitting may be applied to cosmetic surgery.

Further, the Onyshkevych reference is believed to constitute non-analogous art with respect to the Massengill reference. One looking to solve problems associated with cosmetic surgery simply would not look to garment fitting art for solutions. Thus, there is no motivation to combine the Onyshkevych reference with the Massengill reference.

It is further respectfully submitted that none of the cited prior art addresses the particular problems associated with breast enhancement cosmetic surgery or addresses any of the solutions to these problems addressed by the claimed subject matter.

In view of the foregoing, it is respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a cosmetic surgery procedure”; asking at least one question regarding the body of a patient via the network; answering the question(s) via the network; and using the answers to form a preview image of the patent showing the potential effects of the selected cosmetic surgery procedure without using an image of the patient,” as recited in independent claim 1.

It is further respectfully submitted that none of the cited references, taken either alone or in combination with one another, either disclose or make obvious “selecting a breast enhancement cosmetic surgery procedure” and asking the specific questions of independent claim 18.

It is further respectfully submitted that the dependent claims are independently patentable with respect to the independent claims. None of the cited references either disclose or make obvious the detail of the limitations of the dependent claims. For example, none of the cited references either disclose or make obvious the questions relating to breast surgery of dependent claim 11.

Applicant respectfully request that the Examiner withdraw the holding of finality because the Examiner cited new prior art for new grounds of rejection in this Office Action.

Applicant respectfully submits that all of the claims of the subject patent application are in condition for immediate allowance. Application respectfully requests reconsideration and an early allowance.

Respectfully submitted,
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